

REMARKS/AGRUMENTS

Reconsideration of this application is respectfully requested. Claims 1-19 are pending. Claims 1-19 stand rejected in the Office Action mailed October 8, 2003.

Claims 1-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,154,600 to Newman, et al. ("Newman") in view of U.S. Patent No. 5,613,032 to Cruz, et al. ("Cruz").

Claims 1, 6, 10, and 16 have been amended. It is respectfully submitted that no new matter has been added.

CLAIM REJECTIONS**Rejections Under 35 U.S.C. §103**

The Examiner rejected claims 1-19 under 35 U.S.C. §103(a) as being unpatentable over Newman in view of Cruz. Applicants disagree and submit that claims 1-19 are patentable under 35 U.S.C. §103 in view of the references cited by the Examiner.

In regard to the rejection of claims 1, 6, 10 and 16 under 35 U.S.C. §103(a), the Examiner has stated in part that:

However, Newman does not specifically disclose generating search annotations corresponding to the video and second audio signals via the first audio signal....Thus, the examiner incorporates Cruz...which discloses a system for recording and playing back multimedia events based on titles (col. 7, line 10-13), different speakers (col. 7, line 14-19) and search a desired event (col. 5, line 27-42).

(10/8/03 Office Action, p. 3).

Applicants submit that claims 1-5 are not obvious in view of Newman and Cruz. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Ellis, and Cruz.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of October 8, 2003, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show

why one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claim 1, even if Newman and Cruz were combined, such a combination would lack one or more features of claim 1. Amended claim 1 recites the feature of *converting the annotations into **searchable annotations** using a **voice-to-text conversion system***. (emphasis added) As shown by the following analysis, neither Newman, nor Cruz disclose this feature as stated in applicants' claim 1. Newman provides a media editor for a non-linear editing system. (Newman, title) As the Examiner stated in his Office Action of October 8, 2003, "Newman does not specifically disclose generating search annotations..."

Nor does Cruz disclose "*converting the annotations into **searchable annotations** using a **voice-to-text conversion system***" as claimed by applicant. Cruz describes a system and method for recording, playing back and searching multimedia events wherein video, audio and text can be searched and retrieved. (Cruz, title) More specifically, Cruz describes a derivative track generator 350 that converts original media streams into digitized and searchable streams. (Cruz, col. 6, ll. 55-65) The derivative track generator includes a character recognition device, a speaker identification device, a resolution device, and a track distributor. (Cruz, col.6, l. 66- col. 7, l. 1) Thus, Cruz's derivative track generator does not "*convert the annotations to searchable annotations*", since Cruz does not disclose "*voice-to-text conversion system*" as stated in claim 1. Thus, because neither, Newman nor Cruz disclose "*converting the annotations into **searchable annotations** using a **voice-to-text conversion system***", applicant respectfully submits that claim 1

is not obvious under 35 U.S.C. § 103(a) by Newman in view of Cruz. Given that claims 2-6 depend from claim 1, applicant respectfully submits that claims 1-6 are not obvious under 35 U.S.C. § 103(a).

The Examiner also rejected claim 6 under 35 U.S.C. § 103(a) for the reasons set forth in the rejection of claim 1. Claim 6 discloses substantially similar limitations as claim 1 and recites *"means for converting the annotations into searchable annotations using a voice-to-text conversion system"*. Because Newman, in view of Cruz, does not disclose this feature for the reasons stated above, and given that claims 7-9 depend from claim 6, applicant respectfully submits that claims 6-9 are not obvious under 35 U.S.C. § 103(a) by Newman, in view of Cruz.

The Examiner also rejected claim 10 under 35 U.S.C. § 103(a) for the reasons set forth in the rejection of claim 1. Claim 10 discloses substantially similar limitations as claim 1 and recites *"a voice-to-text conversion system that converts the annotations into searchable annotations."* Because Newman, in view of Cruz, does not disclose this feature for the reasons stated above, and given that claims 7-9 depend from claim 6, applicant respectfully submits that claims 6-9 are not obvious under 35 U.S.C. § 103(a) by Newman, in view of Cruz.

The Examiner also rejected claim 16 under 35 U.S.C. § 103(a) for the reasons set forth in the rejection of claim 1. Claim 16 discloses substantially similar limitations as claim 1 and recites *"converting the annotations into searchable annotations using a voice-to-text conversion system."* Because Newman, in view of Cruz, does not disclose this feature for the reasons stated above, and given that claims 17-19 depend from claim 16, applicant respectfully submits that claims 16-19 are not obvious under 35 U.S.C. § 103(a) by Newman, in view of Cruz.

Applicants respectfully submit that all rejections have been overcome. Consideration of this amendment should lead to favorable action that would overcome all remaining grounds of

objection and/or rejection. Furthermore, applicants request that if the claims are not allowed, that the finality of the Examiner's rejection should be withdrawn.

If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

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